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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,014	08/15/2000	Paul Gallagher	17887-005900US	9986

7590 12/30/2004

Townsend and Townsend and Crew LLP
Two Embarcadero Center 8th Floor
San Francisco, CA 94111-3834

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,014

Applicant(s)

GALLAGHER ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Status

Claims 48 - 55 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 43-47 drawn to authentication of a user, classified in class 705 subclass 67.
- II. Claims 48-55, drawn to Electronic banking, classified in class 705 subclass 35.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I and II are different in function and operation, Invention I claims receiving registration information and utilizing a confirmation code. Invention II discloses neither of these features and further claims receiving a transfer request, that is accepted or rejected.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a serious burden to search all two inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper file on October 12, 2004 the applicant has elected the examination of invention II, directed towards claims 48-55. Affirmation of this election must be made by applicant in replying to this Office action. Claims 43-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 48-55 have been examined.

Response to Arguments

The Applicants arguments filed on October 12, 2004 have been fully considered upon further consideration the previous allowability of claims 48-55 has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48-50 and 53- 55 are rejected under 35 U.S.C. 103(a) as being anticipated by Ito et al. (US Patent 6,039,250) in view of Amos (US Patent 6,554,184) and further in view of Brake Jr. et al. (US Patent 6,032,136).

As per claim 48,

Ito et al. ('250) discloses a computer implemented method of transferring funds from one online account to another, the method comprising the steps of automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient;(Abstract)

receiving a response from the recipient accepting or rejecting the transfer of funds;(Figure 4)

transferring said amount of funds from the first account to a second account associated with the recipient if the response indicates acceptance.(Figure 2)

Ito et al. ('250) does not explicitly disclose "receiving a transfer request from the first user, the transfer request including an amount of funds for transfer from the first online account associated with the first user and identification information for a recipient of the funds". Amos ('184) discloses "receiving a transfer request from the first user, the transfer request including an amount of funds for transfer from the first online account associated with the first user and identification information for a recipient of the funds", (column 2, lines 44-52, also figure 2). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Amos's teaching in order to allow the completion of a financial transaction while providing the convenience to the consumer of completing the transaction at a time outside normal banking hours via the Internet.

Ito et al discloses ...the identification information including an electronic message address for the recipient;(Abstract)

Ito et al. ('250) does not explicitly disclose "opening a first online account in response to a request from a first user to open the first account, receiving credit card account information from the first user, establishing a connection with a server associated with the credit card account, transferring funds from the credit card account to the first account ". Brake, Jr et al. ('136) discloses "opening a first online account in response to a request from a first user to open the first account (Column 2, lines 51-58), receiving credit card account information from the first user,(Column 6, lines 5-26) establishing a connection with a server associated with the credit card account,(Column 6, lines 5-26)

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transferring funds from the credit card account to the first account (column 10, lines 11-18)". It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Brake, Jr et al. teaching in order to allow the consumer to manage credit accounts.

Ito et al. ('250) does not explicitly disclose "receiving credit card account information from the recipient, establishing a connection with a server associated with the credit card account and transferring funds from the credit card account to the second account in response to a withdrawal request from the recipient". Brake, Jr et al. ('136) discloses "receiving credit card account information from the recipient,(Column 6, lines 5-26) establishing a connection with a server associated with the credit card account (Column 6, lines 5-26) and transferring funds from the credit card account to the second account in response to a withdrawal request from the recipient (Column 10, lines 11-18)". It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Brake, Jr et al. teaching in order to allow the consumer to manage credit accounts.

As per claim 49,
Ito et al. ('250) discloses the method of claim 1,
wherein the electronic message address is an e-mail address, and wherein the electronic message is an e-mail message.(Abstract)

As per claim 50,
Ito et al. ('250) discloses the method of claim 48,
Official Notice is taken that "the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID because instant messaging services are an inexpensive form of communication which would serve to reduce the overhead of the systems operation.

As per claim 53,
Ito et al. ('250) discloses the method of claim 48, wherein the transfer request further includes a request for identity confirmation, and wherein the response from the recipient includes identity information responsive to the request for identity confirmation, the method further including the steps of :
automatically sending the identity information to the first user;(Column 5, lines 27-40).
receiving from the first user an acceptance or a rejection of the identity information;(Column 5, lines 41-46, also figure 2)
wherein funds are transferred only if an acceptance is received from the first user.(Figure 4)

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As per claim 54,
Ito et al. ('250) discloses the method of claim 53,
wherein the request for identity confirmation includes a query, and wherein the identity information from the recipient includes an answer to the query.(Column 5, lines 16-39)

As per claim 55,
Ito et al. ('250) discloses the method of claim 48
Official Notice is taken that "method is implemented in a host server, and wherein the electronic message includes a URL link to the host server" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the method in a host server, wherein the electronic message includes a URL link to the host server because this would allow access to the server via Internet.

Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being anticipated by Ito et al. (US Patent 6,039,250) in view of Amos (US Patent 6,554,184) and further in view of Picciallo (US Patent 6,044,360).

As per claim 51,
Ito et al. ('250) discloses the method of claim 48,
Ito et al. ('250) does not explicitly disclose "the response includes a request by the recipient to open an account, and wherein the method further includes the step of opening the second account for the recipient". Picciallo ('360) discloses "the response includes a request by the recipient to open an account, and wherein the method further includes the step of opening the second account for the recipient", (column 10, lines 24-48). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow the senders to set spending limits on the recipients account by limiting the amount of money placed in the account.

As per claim 52,
Ito et al. ('250) discloses the method of claim 48,
Ito et al. ('250) does not explicitly disclose "the response from the recipient includes information identifying the second account". Picciallo ('360) discloses "the response from the recipient includes information identifying the second account", (column 9, lines 1-13). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow recipients account to be uniquely identified.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although

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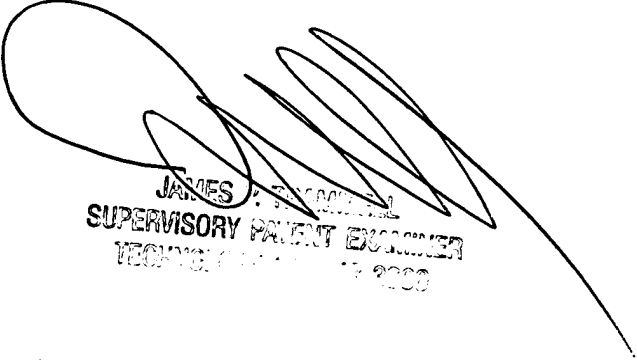
the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
December 27, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 2200